

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 28

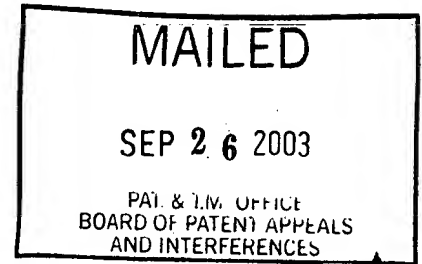
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte MARIE ANGELOPOULOS
and YUN-HSIN LIAO

Appeal No. 2003-2000
Application 09/036,458

ON BRIEF



Before, KIMLIN, TIMM and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicants appeal the decision of the Primary Examiner rejecting claims 1 to 21, all of the pending claims in the application. We have jurisdiction under 35 U.S.C. § 134.

THE INVENTION

The Appellants' invention relates to electrically conductive polymers.

According to Appellants, Brief page 2, conductivity of polymers depends upon morphology. Claim 1 is illustrative:

1. A method comprising:
processing a polymer selected from the group consisting of a precursor to an electrically conductive polymer and an electrically conductive polymer in a solvent comprising a fluorinate solvent, said polymer in said solvent characterized by a dependence of the electrical conductivity of said electrical conductive polymer on the concentration of said polymer in said solvent, said concentration being selected to substantially maximize said electrical conductivity.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Traynor	4,629,798	Dec. 16, 1986
Ikenaga et al. (Ikenaga)	4,772,421	Sep. 20, 1988
Jonas et al. (Jonas)	4,902,573	Feb. 20, 1990
Tan	5,863,658	Jan. 26, 1999 (filed Feb. 17, 1998)
Genies et al. (EP '514) (published European patent application)	EP 0315514	May 10, 1989

THE REJECTIONS

The Examiner entered the following prior art rejections: claims 1-5, 8, 9, 11, 12, 17-19 and 21 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Jonas; claims 1-4, 9-12, 17 and 18 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Traynor; claims 1-4, 6, 7, 9-12 and 16-19 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Ikenaga; claims 1-4, 9-15 and 17-19 as unpatentable under 35 U.S.C. § 102(e) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Tan; and claims 1-4, 6, 7 and 9-18 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over EP '514. (Answer, pp. 4-14).

OPINION

Appellants have indicated that for each ground of rejection “the Board is authorized to select a single claim from the group, preferably the claim broadest in scope, and is requested to decide the appeal as to the ground of rejection on the basis of that claim alone.” (Brief, p. 3). For each rejection over prior art we select claim 1 to represent the rejected claims. 37 CFR § 1.192 (c)(7)(2001).

We reverse the aforementioned 35 U.S.C. §§ 102 and 103 rejections and remand the application to the Examiner.

Upon review of the entire record, we determine that one skilled in the relevant art would not be able to ascertain the scope of claim 1 because no reasonably definite meaning can be ascribed to the language appearing therein. The subject matter of claim 1 is directed to a method comprising processing either (1) a precursor to an electrically conductive polymer or (2) an electrically conductive polymer in a solvent comprising a fluorinate solvent. The remainder of claim 1 further describes (2) the polymer in a solvent as follows: "said polymer in said solvent characterized by a dependence of the electrical conductivity of said electrical conductive polymer on the concentration of said polymer in said solvent, said concentration being selected to substantially maximize said electrical conductivity."

Claim 1 is directed to a method where the single method step specified is "processing". The required method steps cannot readily be discerned. The record is unclear as to what procedures are inclusive of "processing". The claim only provides a further description of the polymer in the solvent. However, there is no indication of how the precursor to an electrically conductive polymer or electrically conductive polymer in a solvent is treated, manipulated or formed. Moreover, the

claim does not indicate the results which are to be achieved by the claimed method.

Accordingly, we reverse all of the Examiner's prior art rejections under §§ 102 and 103 as unpatentable over the applied prior art on procedural grounds¹ and, pursuant to our authority under 37 CFR § 1.196(b) (1997), enter the following new ground of rejection under the second paragraph of 35 U.S.C. § 112.

Claims 1 to 5, 8, 9, 11, 12-19 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons stated above.

Our review of claims under appeal reveals that we are unable to derive a proper understanding of the scope and content thereof. Specifically, the subject matter of claim 1 describes the invention as a method comprising the step of processing. Does processing include doping a polymer, adding additional solvent to the polymer in the solvent, adding an electrical charge to the polymer precursor, removing an electrical charge from the polymer in a solvent, forming films or other structural forms? We are of the opinion that Appellants do not particularly point out and distinctly claim the subject matter which they regard as their invention in a manner such that a skilled person would be able to determine the metes and bounds

¹ We emphasize that this reversal is a technical reversal rather than one based on the merits.

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of the claimed invention with the precision required by the second paragraph of 35 U.S.C. § 112. *See In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Considering the rejection of claims 1-5,8, 9, 11, 12, 17-19 and 21 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Jonas; claims 1-4, 9-12, 17 and 18 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Traynor; claims 1-4, 6, 7, 9-12 and 16-19 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Ikenaga; claims 1-4, 9-15 and 17-19 as unpatentable under 35 U.S.C. § 102(e) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Tan; and claims 1-4, 6, 7 and 9-18 as unpatentable under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over EP '514, we have carefully considered the subject matter defined by these claims, however, for reasons stated supra in our new rejection under the second paragraph of 35 U.S.C. § 112 entered under the provisions of 37 CFR 1.196(b), no reasonably definite meaning can be ascribed to certain language appearing in the claims. As the court in *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious -the claim becomes indefinite.

In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, *see In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we are constrained to reverse, pro forma, the Examiner's prior art rejections of claims. We hasten to add that this is a procedural reversal rather than one based upon the merits of the prior art rejections, as noted above.

OTHER ISSUES

Since we have remanded the application to the Examiner, the Appellants will have an opportunity to amend the subject matter of claim 12 to comply with 35 U.S.C. § 112, second paragraph. If after further prosecution, the issue remains in the application, the Examiner should maintain the rejection of the subject matter under 35 U.S.C. § 112, second paragraph.

APPROPRIATE ACTION

We remand this application to the Examiner for action consistent with the above.

As a final point, we emphasize that we have not considered the merits of any of the Examiner's rejections. We will do so when the application is in condition for a decision on appeal.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the


matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; REMANDED; 37 CFR § 1.196(b)


EDWARD C. KIMLIN
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES


JEFFREY T. SMITH
Administrative Patent Judge

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